

### **REMARKS**

This responds to the Office Action mailed on December 23, 2003.

Claims 1-3 and 14-16 are amended, claims 17-48 are withdrawn, and no claims are added; as a result, claims 1-16 are now pending in this application.

#### **Information Disclosure Statement**

Applicant has enclosed a copy of the Information Disclosure Statement along with a copy of the 1449 Form filed on October 9, 2003 is enclosed herein as requested in the Office Action. Applicant respectfully requests that a copy of the 1449 Form, listing all references that were submitted with the Information Disclosure Statement filed on October 9, 2003, marked as being considered and initialed by the Examiner, be returned with the next official communication.

#### **§103 Rejection of the Claims**

Claim 1 was rejected under 35 USC § 103(a) as being unpatentable over Egendorf (U.S. Patent No. 5,794,221).

Claims 2-48 were rejected under 35 USC § 103(a) as being unpatentable over Egendorf in view of Landry (U.S. Patent No. 5,649,117).

Applicant has amended independent claim 1. This amendment is of the nature of the Examiner's suggestion. Applicant has further amended claims 2-3 and 14-16 to provide antecedent basis for these claims in claim 1 as amended. Applicant respectfully submits that these amendments merely clarify the inventive subject matter in the claims and are not intended to be further limiting.

Thus, in view of the amendments, Applicant respectfully submits the claims are in condition for allowance. Nevertheless, Applicant reiterates the following arguments.

Egendorf discusses a system in which an Internet service provider bills a customer for various purchases of third-party vendor products or services, such that the provider pays the vendor the billed amount minus a transaction fee.

Egendorf does not contemplate identifying a particular matter of a client of a firm, or any other analogous system in which a regular client of an organization identifies a particular transaction by inputting matter identification. Egendorf further fails to contemplate a firm or

functionally similar organization inputting the matter identification and billing information into a computer system, but contemplates only a client's self-initiated online transactions.

Egendorf further fails to contemplate a client account maintained either by Egendorf's service provider or by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in the claims.

Egendorf also fails to consider generating an invoice for such services, as neither the services nor account are present, but further fails to consider calculating a bill payable to the account associated with the client in such a way as the account maintains a positive balance.

Landry is relied upon in rejecting certain of the pending claims to show that receiving notice of an event relating to a matter of a client of the firm will require a second fee be paid by a due date, and issuing an invoice to ensure that the account associated with the client is prefunded to maintain a positive balance after payment of the second fee on the due date. The cited sections of Landry in fact discuss only a system in which a recurring obligation is paid from payor to payee at a regular time interval, and generation of a bill at the regular intervals for the recurring obligation amount that is used to generate TCF and EFT messages causing the funds to be transferred. Landry does not consider payment of a second fee, whether related to a matter of a client of a law firm or otherwise, and further fails to discuss maintaining an account associated with a client of a firm at a predetermined level in anticipation of upcoming fees due.

Thus, the claims are believed to be in condition for allowance. Reexamination and allowance of pending claims 1-16 is therefore respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9581 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date March 23, 2004

By Ann M. McCrackin

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of March, 2004.

Gina M. Uphus

Name

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Signature